

REMARKS

This is in response to the Office Action mailed September 9, 2003, in which claims 1-22 were rejected. With this Amendment, claim 15 has been amended and a replacement drawing sheet is presented containing an amendment to FIG. 3. Reconsideration of the application as amended is respectfully requested.

In the Office Action, the Examiner objected to FIG. 3 for failing to be designated as "Prior Art". One embodiment of the present invention is directed to a CD printing device, such as that depicted in FIG. 3, which includes a print consumables monitoring module. Applicant submits that such a CD printing device is neither taught nor suggested by the prior art. However, since the mechanics of the CD printing device depicted in FIG. 3 are substantially similar to CD printing devices of the prior art, Applicant has submitted a proposed drawing correction to designate FIG. 3 as "Prior Art", as requested by the Examiner. Accordingly, Applicant requests that the objection be withdrawn.

In Section 1 of the Office Action, the Examiner rejected claim 19 under 35 U.S.C. §112, second paragraph, as failing to provide antecedent basis for a "CD printing device". Applicant has amended claim 15 to provide the necessary antecedent basis for claim 19. Accordingly, Applicant believes that the rejection can be withdrawn.

Also in the Office Action, the Examiner rejected claims 1-11 and 14 under 35 U.S.C. §103(a) as being unpatentable over Nakajima et al. (U.S. Patent No. 5,966,555) in view of Hagstrom et al. (U.S. Patent No. 5,927,208). Applicant respectfully disagrees with the Examiner's assessment of the cited references and believes that a *prima facie* case of obviousness has not been established against the rejected claims.

Applicant submits that there is no suggestion or motivation to combine Nakajima et al. with Hagstrom et al. since the copier of Nakajima et al. is unrelated to the CD printer of Hagstrom et al. CD printers are designed to process print jobs to print an image onto a CD, a function that the copier of Nakajima et al. is not designed to perform. Instead, the copier of Nakajima et al. is designed to perform high-speed transference of an image from one source to a recording medium such as paper. Furthermore, copiers and CD printers are distinct arts as evidenced by the fact that Nakajima et al. fail to provide any suggestion of the use of its method in printers and Hagstrom et al. fail to provide any suggestion of the use of its teachings in copiers. Accordingly, there is no suggestion or motivation to utilize the method of Nakajima et al. in the CD printer of Hagstrom et al.

Applicant further submits that the combination of Nakajima et al. and Hagstrom et al. fail to teach or suggest all of the claimed elements of the rejected claims. With regard to independent claim 1, the Examiner found Nakajima et al. to teach the claimed receiving step (a) by the document number setting key 97 in FIG. 2 of Nakajima et al. Applicant respectfully disagrees with the Examiner's assessment of Nakajima et al. In particular, the cited document number setting key 97 is used to input the number of documents that are placed on the document stacker 509 of the automatic document feeder [col. 8, lines 35-37], and is unrelated to a copy number of a print job that represents "the number of copies of the image file that are to be printed", as described in claim 1.

Additionally, the Examiner fails to identify any disclosure of a print job in Nakajima et al. Applicant submits that this is due to the fact that Nakajima et al. relates to a copier rather than a printer. As explained above, the copier of Nakajima et al. does not receive print jobs that include "an

image file and a copy number". Instead, Nakajima et al. must read the image of the source document to be copied using an image reader [col. 5, lines 1-52] rather than receive a print job that includes the image file. Accordingly, Nakajima et al. fail to teach or suggest a step of "receiving a print job, wherein the print job includes an image file and a copy number representing the number of copies of the image file that are to be printed", as described in claim 1.

Additionally, Nakajima et al. fail to teach the determining step (b) of claim 1. The passage of Nakajima et al. cited by the Examiner [col. 3, lines 1-7] fails to provide any teaching or suggestion of an analysis of a print job since Nakajima et al. does not utilize print jobs. Instead, the amount of remaining toner that is determined in the method of Nakajima et al. is based upon "the amount of toner for an image forming operation for a sheet", which is believed to be a preset value. Therefore, unlike the present invention that determines the amount of print consumable that is requested by the print job based upon a current or present print job, the remaining amount of toner is not based upon a present copying job, or the actual source of the copying job. Accordingly, Applicant submits that Nakajima et al. fail to teach or suggest a step of "determining a requested print consumable amount defined as an amount of print consumable needed to render the print job" as described in claim 1.

The Examiner also found Nakajima et al. to teach or suggest the interrupting step (e) of claim 1 at col. 3, lines 23-25 and col. 14, lines 51-54. Applicant respectfully disagrees with the Examiner's assessment of the cited passages. In particular, nowhere in the cited passages does Nakajima et al. provide any suggestion of "interrupting rendering the print job, prior to rendering the print job, when the requested print consumable amount exceeds the remaining print consumable amount",

as described in claim 1. In fact, there is no discussion of stopping or interrupting the copying process at all. Instead, the passage at col. 3, lines 23-25 is completely unrelated to requested and remaining print consumable amounts and only provides that an alarm is triggered for "notifying the user of an expected shortage of sheets when the remaining number of sheets is smaller than the necessary number of sheets." Similarly, col. 14, lines 51-54 is unrelated to requested and remaining print consumable amounts and only discusses that multiple interruption times could be displayed. Such interruption times relate to the time when paper sheets and staples may run out, for example. Therefore, Applicant submits that Nakajima et al. fail to provide any teaching or suggestion of the interrupting step (e) of claim 1.

The Examiner also found that it would have been obvious to combine the monitoring method of Nakajima et al. with the CD printing device of Hagstrom et al. In particular, the Examiner found that "[s]ince each CD uses almost the same amount of print consumable, one would have been motivated to apply such an implementation to calculate and notify the user if an input CD print job can be completed as planned." As stated above, Applicant agrees that Nakajima et al. fails to calculate a requested print consumable amount as described in claim 1 and, instead, requires the pre-setting of the toner amount that is used to perform an image forming operation. As a result, even if the Examiner's argument is assumed to be valid, the combination of Nakajima et al. with Hagstrom et al. would still not result in the invention described in claim 1 because the combination fails to perform a step of "determining a requested print consumable amount defined as an amount to print consumable needed to render the print job" by relying on a preset print consumable amount for each CD.

Accordingly, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness against independent claim 1, and requests that the rejection be withdrawn. Additionally, Applicant submits that claims 2-11 and 14 are allowable as being dependent from allowable base claim 1, and requests that the rejections be withdrawn.

Also in the Office Action, the Examiner rejected claims 12 and 13 under 35 U.S.C. §103(a) as being unpatentable over Nakajima et al. in view of Hagstrom et al., and further in view of Garr et al. (U.S. Patent No. 5,802,420). Applicant respectfully believes that independent claim 1 is presently in condition for allowance for the reasons set forth above. Accordingly, Applicant submits that claims 12 and 13 are allowable as being dependent from allowable base claim 1, and requests that the rejections be withdrawn.

Also in the Office Action, the Examiner rejected claims 15-22 under 35 U.S.C. §103(a) as being unpatentable over Nakajima et al. and Hagstrom et al. and further in view of Garr et al. In rejecting independent claim 15, the Examiner applied the same reasoning used to reject claims 1-12 as to all elements of claim 15 except elements (i) and (j). Applicant respectfully disagrees with the rejections.

Applicant submits that the cited references fail to teach at least steps (a)-(d) and (g), substantially for the reasons set forth above with respect to claim 1. However, one way in which claim 15 differs from claim 1 is that the print job that is received from a user in the receiving step (a) "includes a number of image files that are to be rendered". The Examiner has failed to provide any indication as to where a step of providing such a print job is taught or suggested in the cited references. Accordingly, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness against independent claim 15, and requests the rejection be withdrawn. Additionally,

Applicant submits that claims 16-21 are allowable as being dependent from allowable base claim 15, and requests that the rejections be withdrawn.

The Examiner found Garr et al. to disclose the system of claim 22. In particular, the Examiner found Garr et al. to disclose the claimed computer and the software application in col. 4, lines 49-67. However, the Examiner failed to provide any indication as to where the print consumables monitoring module of claim 15 is taught or suggested. Accordingly, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness against claim 22 since the prior art fails to teach or suggest all of the claimed elements. Accordingly, Applicant requests that the rejection be withdrawn.

In view of the above comments and remarks, it is believed that the present application is in condition for allowance. Consideration and favorable action is respectfully requested.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

WESTMAN, CHAMPLIN & KELLY, P.A.

By: 

Brian D. Kaul, Reg. No. 41,885
Suite 1600 - International Centre
900 Second Avenue South
Minneapolis, Minnesota 55402-3319
Phone: (612) 334-3222 Fax: (612) 334-3312

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